REMARKS

Claims 14-15, 17-19, 22, 25-28, 30-33 and 42-51 were pending. By this Amendment claims 14, 15, 18, 19, 27, 28, 30-33, 42, 45 and 48-51 have been canceled. Claims 17, 22, 43 and 44 have been amended. Upon entry claims 17, 22, 25, 26, 43, 44, 46 and 47 are now pending.

Claim 17 has been amended to change its dependency and to make conforming changes related to the change in dependency. Claim 22 has been amended to change its dependency. Claim 43 has been amended to further distinguish over the Thorne, et al. reference. Support for "m is 1, 2, 4 or 5" in claim 43 can be found, *inter alia*, on page 3, line 7, and in original claim 14. Support for 2,6-dimethylphenyl may be found, *inter alia*, on page 5, lines 17-18. Claim 44 has been amended to make conforming changes in view of the amendment of claim 43, from which it depends. Applicants maintain that the amendments do not raise an issue of new matter. Entry of this Amendment is respectfully requested.

Paragraph 5 of the Office Action states, "a new ground(s) of rejection is made in view of Thorne et al. (US Pat. 4,098,816) and WO 01/36365." A rejection over Thorne appears at paragraphs 10-12 of the Office Action. But the Office Action does not contain any rejection based on WO 01/36365. Clarification is respectfully requested.

NO STATUTORY DOUBLE PATENTING

Claims 4-15, 17-19, 22-28 and 30-33 have been provisionally rejected under 35 U.S.C. §101 as allegedly claiming the same invention as claims 1-33 of copending Application No. 11/841,489 (the '489 application). The rejection is respectfully traversed.

In the Amendment filed May 1, 2008 in the subject application applicants undertook to either cancel or amend claims of the '489 application to eliminate any statutory double

patenting. And applicants made good on that pledge. The claims directed to methods of treatment have been canceled from the subject application, and the claims directed to pharmaceutical compositions and biologically active agents have been canceled from the '489 application. The claims pending in the subject application are directed to pharmaceutical compositions (claims 17, 25, 43, 44 and 46) and biologically active agents (claims 22, 26, 47). In contrast, all of the claims pending in the '489 application are directed to methods of treatment (claims 1, 2, 4-7, 16 and 34-39). Accordingly there is no statutory double patenting. Applicants respectfully submit that the rejection is improper and should be withdrawn.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 19, 22 and 26 have been provisionally rejected on grounds of alleged obviousness-type double patenting over claims 1-5 of copending Application No. 11/844,431 (the '431 application) and claims 1, 6-7, 9-10, 15 and 22-23 of copending Application No. 11/844,432 (the '432 application). Applicants note that claims 1, 4 and 5 have been canceled from the '431 application.

The rejections are respectfully traversed. The '431 application and the '432 application were filed after the subject application. Accordingly, upon an indication of otherwise allowable subject matter the provisional obviousness-type double patenting rejections should be withdrawn and the subject application should be allowed to issue as a patent without a terminal disclaimer. MPEP §804(I)(B)(1), 8th ed., Rev. 7, July 2008, page 800-17, right column.

PATENTABLE OVER THORNE

Claims 4-15, 17-19, 22-28, 30-33 and 42-51 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by, or under 35 U.S.C. §103(a) as allegedly being obvious over Thorne (U.S. Patent No. 4,098,816). This rejection is respectfully traversed.

The rejection states that "it is shown in example 12 in the table bridging cols. 11-12 a compound[] wherein the methyl moieties are located on the 2nd and 5th carbon of the phenyl moiety. . . . [T]o modify the substituted carbocyclic (i.e. phenyl) with 2 methyl groups at the 2nd & 6th position on the phenyl would have been within the skill of one of ordinary skill in the art." (December 22, 2008 Office Action, page 5). But the substitution pattern on the terminal phenyl ring is not the only difference between the teaching of the reference and the claimed invention.

In the claims of the subject application the carboxylic acid or ester substituent is in the meta-position with respect to the benzyloxy substituent. In contrast, in the reference compounds the carboxylic acid or ester substituent is in the para-position with respect to the benzyloxy substituent. Accordingly, there is no overlap between the reference compounds and the compounds recited in the pending claims. Thorne discloses the synthesis and testing of over 100 compounds for hypolipidemic and/or hypoglycemic activity, and further teaches a genus that encompasses more than a million compounds. All are in the para-configuration. In the extensive research reported by Thorne, no compound in the meta-configuration was explored. Applicants submit that there was no suggestion or motivation for the person of ordinary skill in the art to choose compounds in the meta-configuration.

Additionally, in the 2,5-dimethyl reference compound cited in the Office Action the carboxylic acid ester moiety is CO_2Et, corresponding to m=0 in the nomenclature of the claims under examination. In contrast, in the pending claims m is not zero.

Starting with the reference compound cited in the Office Action, one would have had to change the position of the carboxylic acid, change the length of the carboxylic acid, and change the substitution pattern on the terminal phenyl ring. No suggestion or motivation to make all of these changes in a coordinated way can be found in the prior art or in the

ordinary level of skill in the art. Applicants respectfully submit that the prior art rejection over Thome has been overcome.

CONCLUSION

In view of the amendments and the preceding remarks, applicants submit that this application is now in condition for allowance. Reconsideration and withdrawal of all rejections and prompt notice of allowance are respectfully requested.

No fee is believed necessary in connection with the filing of this Amendment. If any fee is required, the Commissioner is hereby authorized to charge the amount of such fee to Deposit Account No. 50-1677.

Respectfully submitted,

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